

U.S.S.N. 10/005,695

Enos et al.

Response to Office Action and Request for Reconsideration

REMARKS

Claims 1-27 are pending in this application. Attached hereto is a complete listing of all claims in the application, with their current status listed parenthetically. By this response claims 1-11, 17 and 27 have been amended, and are presented with markings indicating their current amendments. Claims 12-16 have been canceled. New claims 28 and 29 have been added. These amendments and new claims add no new matter and are fully supported by the application as filed.

Rejection Under 35 U.S.C. § 112, 2nd paragraph (indefinite)

In paragraph 2 of the Office Action the Examiner rejects claims 1-17 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. By this response, Applicant amends claims 1-11 and 17 and cancels claims 12-16. These amendments have addressed the Examiner's concerns regarding "who or what is receiving a formulary" in claim 1, and the Examiner's argument that claims 2-17 "are replete with similar ambiguities". Additionally, other matters of form have been amended, such as replacing the word "said" with the word "the" for example.

In view of the above, Applicant respectfully requests the Examiner reconsider and withdraw this rejection.

Rejection Under 35 U.S.C. § 102

In paragraph 3 of the Office Action the Examiner rejects pending claims 1-11, and 17-27 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,845,255 ("Mayaund"). As discussed below, Applicant respectfully traverses this rejection.

A. The Law of Anticipation and Enabling Prior Art References

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. The identical invention must be shown in as complete detail as is contained in the claim. *Id.*

However, Applicant submits that independent claim 1, as amended, has elements that cannot be found expressly or inherently in Mayuand. For example, claim 1 includes the limitations of receiving a medical group formulary and deriving a physician specific formulary from the medical group formulary, where the physician is a member of the medical group. Mayuand fails to teach, imply, or suggest that a formulary for specific physician within a medical group may be derived from a medical group formulary. Mayuand teaches a patient centric compilation of information illustrated in Col. 8 beginning at line 34 the "Virtual Patient Record". This teaching provides a physician user with information from "all institutions, including independent physicians, hospitals, HMOs, insurance companies, and so on known to have source historical records on that patient." (Col. 8, lines 52-58). Mayuand fails to teach, suggest or imply methods of generating medical group and physician specific formularies.

Additionally, Mayuand fails to teach, suggest or imply the elements of generation of a physician specific formulary and a pre-printed prescription pad. Mayuand teaches a system by which a provider may select through a series of choices and menus, a prescription for a specific patient at the place of care. The information provided to the physician at the point of care includes a "virtual patient record" (Col. 8, beginning at line 33). A host of "intelligent data lists that are, where possible, exhaustive and list, for example, all prescribable drugs, all conditions, all formularies or all patients." (Col. 8, line 24-28). The device taught by Mayuand may include "Bio-pattern recognition of personal user characteristics, including for example, handwriting, signatures, voice patterns, and fingerprints." (Col. 9, lines 16-20) The device taught by Mayuand may be "user adaptive" involving offloading techniques and permanent storage. (Col. 11, lines 37-40).

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In contrast, the present invention provides a pre-printed prescription form. A pad that all physicians use in their daily practice. A pad that provides useful information to the user without the necessity of selection of complex menus, user interfaces and fingerprint recognition. The device taught by Mayuand is complex and a significant departure from standard medical practice. Its adoption by health care professionals that must, on occasion make significant time critical decisions is in question. The present invention however provides significant useful information to the user in a format they use on a daily basis. The generation and analysis of the information on the pre-printed prescription pad are not completed at the point of care, where time may be a critical commodity. These inventions are apples and oranges. Mayuand fails to teach or suggest explicitly or inherently the methods and apparatus of the present invention.

Applicant respectfully submits that the above described amendments and the accompanying response have traversed the rejection to independent claim 1. Claims 2-11 and 17 depend from claim 1, and accordingly it is respectfully submitted that the rejection of those claims has been traversed by virtue of their dependency on claim 1. Therefore the Applicant respectfully requests the Examiner reconsider and withdraw the rejection to claims 1-11 and 17.

In paragraph 18 of the Office Action the Examiner rejects independent claim 18 as anticipated under 35 U.S.C § 102(b) by Mayaud. As discussed below, the Applicant respectfully traverses this rejection.

Applicant submits that independent claim 18, as amended, contains elements not taught, implied or suggested by Mayuand. Specifically, claim 18 contains elements related to physician specific information not taught suggested or implied in Mayaud. (see amendments) as discussed above, Mayaud teaches a patient centric compilation of information illustrated in Col. 8 beginning at line 34 the "Virtual Patient Record". This teaching provides a physician user with information from "all institutions, including independent physicians, hospitals, HMOs, insurance companies, and so on known to have source historical records on that patient." (Col.

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8, lines 52-58). Mayuand fails to teach, suggest or imply methods of generating medical group and physician specific formularies.

Applicant respectfully submits that the above described amendments and the accompanying response have traversed the rejection to independent claim 18. Claims 19-25 depend from claim 18, and accordingly it is respectfully submitted that the rejection of those claims has been traversed by virtue of their dependency on claim 18. Therefore the Applicant respectfully requests the Examiner reconsider and withdraw the rejection to claims 18-25.

In paragraph 23 of the Office Action the Examiner rejects independent claim 26 as anticipated under 35 U.S.C § 102(b) by Mayaud. As discussed below, the Applicant respectfully traverses this rejection.

Applicant submits that independent claim 23, as amended, contains elements not taught, implied or suggested by Mayuand. Specifically, claim 23 contains elements related to physician specific information not taught suggested or implied in Mayaud. (see amendments) as discussed above, Mayaud teaches a patient centric compilation of information illustrated in Col. 8 beginning at line 34 the "Virtual Patient Record". This teaching provides a physician user with information from "all institutions, including independent physicians, hospitals, HMOs, insurance companies, and so on known to have source historical records on that patient." (Col. 8, lines 52-58). Mayuand fails to teach, suggest or imply methods of generating medical group and physician specific formularies.

Applicant respectfully submits that the above described amendments and the accompanying response have traversed the rejection to independent claim 26. Therefore the Applicant respectfully requests the Examiner reconsider and withdraw the rejection to claim 26.

In paragraph 24 of the Office Action the Examiner rejects independent claim 27 as anticipated under 35 U.S.C § 102(b) by Mayaud. As discussed below, the Applicant respectfully traverses this rejection.

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Applicant submits that independent claim 27, as originally filed, contains elements not taught, implied or suggested by Mayaud. Specifically, claim 27 contains elements related to physician specific information not taught suggested or implied in Mayaud. As discussed above, Mayaud teaches a patient centric compilation of information illustrated in Col. 8 beginning at line 34 the "Virtual Patient Record". This teaching provides a physician user with information from "all institutions, including independent physicians, hospitals, HMOs, insurance companies, and so on known to have source historical records on that patient." (Col. 8, lines 52-58). Mayaud fails to teach, suggest or imply methods of generating medical group and physician specific formularies.

Applicant respectfully submits that rejection to independent claim 27 has been traversed. Therefore the Applicant respectfully requests the Examiner reconsider and withdraw the rejection to claim 27.

Rejection Under 35 U.S.C. § 103

In paragraphs 26-30 the Examiner rejects claims 12-16 as obvious under 35 U.S.C § 103(a) over Mayaud. By this response claims 12-16 have been canceled rendering this rejection moot.

In paragraph 27 the Examiner rejects claim 17 as obvious under 35 U.S.C § 103(a) over Mayaud. As discussed below the Applicant respectfully traverses this rejection.

B. The Law of Obviousness

In order to establish a *prima facie* case of obviousness, three basic criteria must be met:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

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reasonable expectation of success. Finally, the prior art reference (or references when combined), must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure." M.P.E.P. § 2142.

"If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious." M.P.E.P. § 2143.03. Because claim 17 depends from and further limits and defines the invention of claim 1, claim 17 is also patentably distinct from the art being considered and the arguments above with respect to claim 1 apply equally here.

Applicant respectfully submits that rejection to dependent claim 17 has been traversed. Therefore the Applicant respectfully requests the Examiner reconsider and withdraw the rejection to claim 17.

Conclusion

Applicant believes that this Response has addressed all items in the Office Action and now places the application in condition for allowance. Accordingly, favorable reconsideration and allowance of claims 1-11, and 17-27 at an early date is solicited. Should any issues remain unresolved, the Examiner is invited to telephone the undersigned.

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